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PATENT

Paper No.

File: Kor1-CIP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors : Charles Kormanik, Jr.
Serial No. : 08/802,472
Filed : February 18, 1997
For : THEMATIC PACKAGING SYSTEM
Group Art Unit : 3208
Examiner : Luby, M.

Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

TRANSMITTAL LETTER

SIR :

Please enter the following enclosed documents in the above-identified patent application.

1. Reply Brief on Appeal on Behalf of Appellant (in triplicate).

APPLICANT CLAIMS SMALL ENTITY STATUS. The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235.

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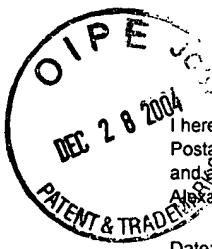
Respectfully submitted,



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REPLY BRIEF ON APPEAL ON BEHALF OF APPELLANT

I. APPELLANTS REPLY TO EXAMINER'S RESPONSE

A. 35 §U.S.C. 102(b) Rejections: Claims 5, 9, 11, 22, 28, 30, and 31

1. Legal Standard

In the Answer, the Examiner has not disputed the legal standard for determining anticipation pursuant to 35 U.S.C. § 102. As stated in Structural Rubber Prod. Co. v. Park Rubber Co., 749 F.2d 707, 223 USPO 1264 (Fed. Cir. 1984)

"Anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention. Anticipation is not shown even if ...the differences between the claims and the prior art references are "insubstantial" and the missing elements could be supplied by the knowledge of one skilled in the art."

and In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990):

"For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference...."

2. Cited Art: Gossard

In the Answer, the Examiner has disputed the general characterization of Gossard in the Brief that:

Gossard is silent as to anything being done with the photographs after removal from the container, and Gossard shows photographs, but does not mention the activities of collecting sports memorabilia or collecting signatures.

Compare the Brief at page 14, lines 2-4, with the Answer at page 3, line 19-page 4, line 2.

This is a question of fact, and the Board can determine the scope and contents of the Gossard disclosure. Applicant believes the characterization of Gossard in the Brief is correct.

3. Sec. 102 Rejections

i. Overview

It is respectfully submitted that the Examiner seeks to make out anticipation / obviousness rejections by persistently misconstruing the claims and arguing that the cited art

fits the misconstrued claims. Compare the Examiner's characterization of the claim at the bottom of Page 5 of the Answer with the precise claim requirements. This is not what the claim requires.

The Board had no trouble correctly interpreting the claims as shown in the decision for the first appeal. Precise requirements of the claims must be considered in a statutory patentability examination, and an anticipation / obviousness rejection premised on a misconstrued claim is improper.

Respectfully, Applicant also objects to the Examiner persistently using his personal opinion in support of a rejection. See, e.g., the Answer at page 5, line 12 and again at line 13, etc. Such Examiner opinion is improper and not a basis for examination of a patent application in accordance with 35 U.S.C. §102 and §.

ii. Claims 5 (see also 51): Critique of the Examiner's Answer

As to the precise claim requirements, the Answer is insufficient because it does not respond to the showing in the Brief that there is no Examiner contention that can consistently be applied to Gossard to meet all the claim requirements collectively. The attention of the Board is directed to the discussion in the Brief (pages 15-18), where, the Brief discusses the three Examiner theories (1a, 1b, and 1c) to demonstrate that Gossard can address the ... activity associated with the icon... claim requirement only under one of theory (1a). However, this Examiner theory (1a) conflicts with another claim requirement ... article is used during the activity after removal... when applied to Gossard. Thus, the Examiner's Answer still offers no way to read Gossard consistently on properly construed claim requirements as a whole.

In the Answer, the Examiner skips the particularities of claim elements under the theories and takes issue with the general discussion of Gossard in the introduction of the Brief, as discussed above. (Contrast the Examiner's Answer at page 4, lines 1-2 with the Brief page 14, lines 2-4) and the claim element discussed at page 18 of the Brief. However, the Answer is

insufficient. The Examiner has not provided a way to read Gossard consistently on properly construed claim requirements as a whole. And a reason why the Examiner has not answered the argument in the Brief is because there is no answer: Gossard is insufficient to prove anticipation.

Notwithstanding this argument in the Brief, in the Answer beginning at page 4, lines 1-2, the Examiner attempts to dispute the general overview of Gossard in the Brief at page 14. The Examiner contends that the claimed ... article is used during the activity after removal... portion of the claim is a mere “intended use” (Answer at page 4, line 6). But this is a mischaracterization of the claim as a whole, which makes a structural requirement:

the shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package....

The method step requires constructing the package so that have a particular shape, and the claimed ... article is used during the activity after removal... limits the claimed shape so as to confer a structural limitation and not be a mere intended use of the article. Therefore, the claim requires a manipulative difference as compared with the prior art (Gossard) and is not a mere intended use of the article, say, after performance of the method step.

This distinction is sufficient to reverse an anticipation rejection. See too the Examiner theories 1a, 1b, and 1c.

But there is even further reason why the evidence is insufficient to show statutory anticipation. As to the step of making a combination for combined marketing, the Examiner essentially concedes that Gossard is not an anticipatory teaching. Rather than point to a teaching in Gossard which is necessary for statutory anticipation, the Examiner offers his opinion to supplement Gossard. At page 5 the Examiner states: “Since there would be no point in making something for profit and then not selling it, the Gossard product must be marketed.” This is not a Gossard teaching. This is an Examiner opinion, and this is not statutory

anticipation evidence. Pursuant to Boyd (see Brief), "every element of the claimed invention must be identically shown in a single reference..." for anticipation, and the Examiner's reasoning is not a teaching.

More so, the Examiner's quoted opinion in the Answer is not consistent with Gossard, as discussed in Sec. 3, pages 18-19 of the Brief. Gossard teaches a container for holding photographs, and does not teach ...making a combination... for combined marketing. The Gossard holder could be sold separate from the photographs, for example, and thus there has not even been an allegation of inherency. Gossard is insufficient evidence for statutory anticipation of all claim elements, and supplementing the evidence with Examiner opion is not §102 showing.

To place this all in perspective, the general problem with the rejection is it seeks to use an article of manufacture teaching to reject claims directed to a method of making, and it is just not clear from the article how it was made. Thus, there is no teaching of the *raison de etre* for the method steps of the present invention: e.g., of: making a combination of a thematic package and an article contained in the package for combined marketing...

As stated in the Brief, pursuant to In re Bond:

"For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference...."

Gossard does not identically show the method step of:

constructing... the shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package

or

...making a combination... for combined marketing

and especially not both in combination.

The MPEP Sec. 2131 provides that:

"A claim is anticipated only if each and every element as set forth in the claim is

found, either expressly or inherently described in a single prior art reference. ‘*Verdicaal Bros. v. Union Oil Co. of California*, 814 F. 2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be found in as complete detail as contained in the ...claim.” *Richardson v Suzuki Motor Co.*, 969 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required in the claim.”

Pursuant to the MPEP, Gossard is insufficient evidence of statutory anticipation, and therefore, as per the prior Board Decision, “the examiner has not presented sufficient evidence from the prior art of the totality of the claim was suggested to an ordinary artisan, and thus there is no statutory anticipation.”

(Additionally, with no teaching or suggestion thereof, no combination of cited art can render the claims anticipated or obvious, as discussed below. This is determinative of all claim rejections, as discussed further herein, as there is a parallel to other independent claim requirements, and this argument is to be incorporated by reference in the rejection of each of the claims.)

4. Claims 8-15

i. Overview

The claims stand or fall separately, and particular requirements of each claim must be considered under particular statute that forms the basis for the Examiner’s withholding of a patent. Applicant therefore objects to the Answer at page 5 grouping claims 8-15 because the grouping intermingles Sec. 102 and Sec. 103 rejections, and thus is improper.

Applicant also objects to “the Examiner’s opinion” (Answer at page 5, line 10-11) as this opinion is improper and not relevant to statutory (obviousness or) anticipation.

ii. Critique of the Examiner’s Answer

First, Applicant again objects to the misconstruing of the claims. The Examiner is attempting to make out anticipation / obviousness rejections by misconstruing the claim and arguing that the cited art fits the misconstrued claim. See the bottom of Page 5 of the Answer.

This is not a correct statement of the claim requirements.

Second, the Answer has not addressed all arguments presented in the Brief, and as such, the Answer is not responsive nor sufficient.

Third, the Examiner contends that the required shapes are a matter of design choice. "Mere design choice" is not within the reach of Sec. 102 anticipation. See the MPEP Sec. 2131. Thus, this contention in the Examiner's Answer can only be applicable to those claims rejected pursuant to Sec. 103, which are discussed below in the section of the Reply pertaining to Sec. 103 rejections.

As to those of the misgrouped claims rejected pursuant to Sec. 102, the Examiner has not responded to the sections in the Brief corresponding to the respective claims. Please see the Brief at pages 20-21 for further discussion of cooperation of the elements in a consistent interpretation of claim 9 requirements, pages 21-22 for claim 11 requirements, and pages 22-24 for claim 13 requirements. The required cooperation of the elements make the respective method claims distinct from the teaching of Gossard.

As per these unaddressed sections in the Brief, pursuant to In re Bond:

"For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference..."

and Gossard does not identically show the claimed method steps as a whole.

4. Claim 20

i. Critique of the Examiner's Answer

Again, the Answer does not respond to the respective arguments presented in the Brief. The Examiner contends that, however, the method step of constructing the package to have additional utility independent from containing said article is a mere intended use of the article, and thus entitled to no patentable weight. See Answer at page 6. However, this is a method claim, not an apparatus claim, and the method step must be considered in the context

of the claim as a whole. The method step requires action in the course of constructing, not a use intended after the constructing step has been performed, thereby conferring a structural limitation. This is not the situation of an intended use of an article, but rather the situation of whether a method step has not been shown to have been anticipated based on Gossard.

As also discussed above, the Examiner's contention reflects the difficulty of applying article art to a method claim, and because the evidence does not show the reason for the method claimed herein, the Examiner has speculated about the cited art as applied to a mischaracterized claim. The cited art itself does not teach the required constructing step, especially in the context of the claim as a whole, and thus the Examiner has not met his burden of proof for a statutory anticipation rejection. Pursuant to In re Bond:

"For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference..."

and Gossard does not identically show the claimed method steps as a whole.

5. Claim 22

i. Critique of the Examiner's Answer

Yet again the Answer is not responsive to the arguments presented in the Brief. In connection with the requirement wherein the constructing step of claim 22 is further limited to include constructing the package out of a substance capable of receiving subsequent writing from a pen or magic marker, the Examiner contends that Gossard teaches this. See the Answer beginning at the bottom of page 6.

Applicant maintains that Gossard is silent as to the substance used in construction, and more so, requiring constructing the package out of a substance of certain capability cannot be a mere intended use, thereby further negating the Examiner's contention regarding claim 20. Additionally, the Examiner has offered no evidence that all substances are capable of receiving the claimed writing, and the Examiner offers no more than speculation as

to the substance of which Gossard is made. Again the cited art shows no evidence of the required constructing step as further defined in claim 22, especially in the context of the claim as a whole, and thus the Examiner has not met his burden of proof for a statutory anticipation rejection. Pursuant to In re Bond:

"For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference..."

and Gossard does not identically show the claimed method steps as a whole.

6. Claim 28

i. Critique of the Examiner's Answer

The Answer does not respond to all arguments presented in the Brief. The Examiner contends that "Since figures 2 and 5 of Gossard show multiple articles, this limitation is met." The Examiner's contention depends on a mischaracterization of the claim. This is not what is required by the claim.

Claim 28 further defines base claims, wherein the activity is defined, and it is the combination of requirements in cooperation of the claim as a whole that must be considered. The attention of the Board is respectfully directed to the discussion in Applicant's Brief (pages 15-18) of the cooperating requirements involved with the activity, i.e., requirement 1 vis-à-vis Examiner theories 1a, 1b, 1c; in combination with requirement 2. In that section of the Brief it was shown that there is no Examiner contention that can consistently be applied to Gossard to meet the claim limitations as a whole. See too Applicant's Brief regarding Claim 28. The contention in the Answer regarding claim 28 ignores the requirements of the activity in the context of the claim as a whole.

The Examiner has mischaracterized the requirements of the claim to attempt to fit Gossard because and the evidence cannot fit all requirements when the claim when properly construed. Pursuant to In re Bond:

"For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference..."

and Gossard does not identically show the claimed method steps as a whole.

6. Claim 30

i. Critique of the Examiner's Answer

Again, the Answer is not responsive to all the arguments presented in the Brief.

For claim 30, the Examiner relies on his contentions regarding claim 5. Applicant relies on both the portion of the Brief pertaining to claim 5 and further on the portion pertaining to claim 30. The Examiner has not responded to the respective arguments presented in the Brief and has not shown anticipation of the claim as a whole.

As further stated above, the Examiner has not laid out one theory of claim construction that consistently addresses all claim limitations, and instead hops from theory to theory to address the claim requirements with separately and contradictory theories.. With no consistent theory offered or existing, Gossard is not sufficient evidence to show anticipation.

Pursuant to In re Bond:

"For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference..."

and Gossard does not identically show the claimed method steps as a whole.

7. Claim 31

i. Critique of the Examiner's Answer

As to claim 31 the Examiner also mischaracterizes the claim, as the Board can see by contrasting the Answer at page 7 with the precise claim requirements. The Answer is also insufficient and not responsive to all arguments presented in the Brief. Applicant relies on the argument set out in the Brief at page 33, e.g., that Gossard explicitly teaches that pieces are "connected", in contrast to the separable requirement of the claim. Pursuant to In re Bond:

"For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference..."

and Gossard does not identically show the claimed method steps as a whole.

8. Summary

It is respectfully submitted that no one would ever have thought of a method for making a combination of a thematic package and a removable article contained in the package for combined marketing (as more precisely set out in the claims) from Gossard, except for the Examiner responding to Appellant's application for a patent. Further, the claims require method steps, not an article of manufacture, and the reason for the method has not even been found in the cited art, so the Examiner is speculating about a method from the inadequate evidence of the article in Gossard.

The claimed method steps, when correctly construed, are not anticipated by Gossard. The MPEP Sec. 2131 provides that:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdicaal Bros. v. Union Oil Co. of California*, 814 F. 2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be found in as complete detail as contained in the ...claim." *Richardson v Suzuki Motor Co.*, 969 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required in the claim."

And as per In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990): "For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference...." Gossard does not teach the claimed shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package in combination with the claimed ...making a combination... for combined marketing. Accordingly, the Examiner has not presented sufficient evidence from the prior art of the totality of each claim 102-rejected claim was suggested to an ordinary artisan. Therefore, the rejections for statutory anticipation

based on Gossard should be reversed.

**B. 35 U.S.C. § 103: Claims 8, 10, 12, 14, 15, 17, 18, 23, 29, 49, 51, 53, 55
57 (Gossard)**

1. Legal Standard

In the Answer, the Examiner has not disputed the legal standard for determining obviousness pursuant to 35 §U.S.C. 103. The attention of the Board is respectfully directed to the Brief at pages 34-35.

2. Claims 8-15

i. Overview

As stated above with regard to the Sec. 103 rejections being misgrouped with the Sec. 102 rejections in the Answer, the claims stand or fall separately, and particular requirements of each claim must be considered under particular statute that forms the basis for the Examiner's withholding a patent. Applicant therefore objects to the Answer at page 5 grouping claims 8-15 because the grouping intermingles Sec. 102 and Sec. 103 rejections, and therefore is improper. This section addresses claims 8, 10, 12, 14, and 15 as the others of this group are addressed above regarding Sec. 102 rejections.

Applicant also objects to "the Examiner's opinion" (Answer at page 5, line 10-11), which is impermissible and irrelevant to statutory obviousness (or anticipation in the mis-grouped claims). The attention of the Board is respectfully directed further to the Brief at pages 20-21 for further discussion of cooperation of the elements in a consistent interpretation of claim requirements. The rejection and Answer does not completely address the requirements of the independent claims, and thus cannot address the dependable claim requirements. The cooperation of the elements make the respective method claims unique and render the Examiner's imprecise claim interpretations even more untenable.

ii. Critique of the Examiner's Answer

The Examiner persistently misconstrues the claims and does not address the arguments presented in the Brief as regards the respective claims. The Board is respectfully requested to read the Brief in connection with the Examiner's Answer, which is submitted to be nonresponsive and thus insufficient.

First, as to the misconstruing of the claims, the Examiner is attempting to make out anticipation / obviousness rejections by misconstruing the claim and arguing that the cited art fits the mischaracterized claim. See the bottom of Page 5 of the Answer. This is not a correct statement of the claim. It is improper for the Examiner to withhold a patent on statutory anticipation / obviousness by misconstruing the claims.

Second, as to those of the misgrouped claims rejected pursuant to Sec. 103, the Examiner has not responded to the sections in the Brief. In the context of the argument of claim 5 wherein the Brief demonstrates how no theory of the Examiner can account for all claim limitations, please additionally see the discussion of dependent claims from 5, in the Brief at pages 38-40 for further discussion of cooperation of the elements in a consistent interpretation of claim 8 requirements; pages 40-43 for claim 10 requirements; pages 43-45 for claim 12 requirements; pages 45-47 for claim 14 requirements; and pages 47-50 for claim 15 requirements. The Examiner has not responded to particular arguments set forth in these sections, and the required cooperation of the elements make the respective method claims distinct from the teaching of Gossard.

As to the Sec. 103 rejections, the Examiner has grouped claims 8, 10, 12, 14, and 15; the Examiner contends that the required shapes are a matter of design choice. "Mere design choice."

As to whether these claims involve a mere matter of design choice as to a shape used in carrying out the method, a change in shape is not always mere matter of design choice, and is not one merely because the Examiner asserts so. Pursuant to Sec. 103, the question is

whether it would have been obvious to one having ordinary skill in the art at the time of the invention to have selected the particularly claimed shape in the absence of a specific teaching to do so. Because the Examiner has not presented any evidence to support his contention that the change in shape is merely a matter of design choice, in the context of method claims where there has been no showing that the problem addressed by the instant claims has even been recognized in the prior art, the rejection cannot be sustained. (See the discussion in the Brief re the Southwestern decision.)

The Examiner relies on *In re Kuhle* in the Final Rejection at page 5, but this decision the CCPA held that the rationale of “obvious matter of design choice” applies when a modification solves no stated problem. In contrast to the application in *Kuhle*, the present patent application states the idea of thematic packaging; the specification refers to “three dimensional shapes that can be used to convey information, and thus all these can be used for thematic packaging.” See specification at page 13, lines 24-26, and that portion of the specification. Different shapes convey different information for thematically shaped packaging. See the top of that page in the specification states more about the golf ball shape “packaged in a manner to suggest their use.” More so, unlike the application in *Kuhle*, the subject matter of the instant patent application pertains to a method involving thematic packaging, so understandably the instant claims pertain to the subject matter of design choice in carrying out the method of the claimed invention. Thus, the discussion in the instant specification of thematic packaging and conveying information by the different shapes in a method relating to thematic packaging distinguishes the instant patent application that in *Kuhle*.

In sum, as to each of claims 8, 10, 12, 14, and 15, the Examiner has begged the question of statutory obviousness by not presenting any evidence to support his contention that the change in shape is merely a matter of design choice, and the unsupported contention is contradicted by the statements in the specification as to the reasons for the shapes (method for

thematic packaging), e.g., to convey information (in accordance with other and respective claim limitations). For not completely addressing the issues raised in the Brief and for the reasons discussed above with respect to the “mere design choice” contention, the Examiner has not set out a case of *prima facie* obviousness.

3. Claim 18

The Examiner again misconstrues the claims and does not address all arguments presented in the Brief as regards the claim. See pages 50-53. The Board is respectfully requested to read the Brief in connection with the Examiner’s Answer, which is submitted to be nonresponsive and thus insufficient.

With regard to the claim 18 requirement that

adding an outer layer of packaging to the combination, the outer layer of packaging shaped to visually suggest the associated activity.

(wherein the activity refers further defines the activity set out in Claim 5), the Examiner contends that this method step is a matter of design choice and disclosed by bubble wrap. See in the Answer at page 7. But “bubble wrap” is not visually suggestive of the activity required in the claim.

The Examiner’s contended use of bubble wrap would not constitute *the outer layer of packaging shaped to visually suggest the associated activity*. The Examiner has contended regarding claim 5 that the activity is variously “a sport activity” (theory 1a (see Brief at pages -17), “collecting sports memorabilia” (theory 1b), and “collecting signatures” (theory 1c). The Examiner’s contended “bubble wrap” is not suggestive of any of these activities.

Second, Incorporating the law set out above regarding claims 8-15 above, first, the Examiner has not presented any evidence to support his contention that the change in shape is merely a matter of design choice. In the context of method claims where there has been no showing that the problem addressed by the instant claims has even been recognized in

the prior art. (See the discussion in the Brief re the Southwestern decision.)

Third, unlike the patent application at issue in *Kuhle* (see discussion above), the discussion in the instant specification of thematic packaging and conveying information by the different shapes in a method relating to thematic packaging distinguishes the instant patent application that in *Kuhle*.

For not addressing all the arguments presented in the brief, and in view of the three points raised above, the Examiner has not shown that the claim as a whole is *prima facie* obvious.

4. Claim 29

The Examiner again misconstrues the claims and does not address all the arguments presented in the Brief as regards the claim. See pages 50-53. The Board is respectfully requested to read the Brief in connection with the Examiner's Answer, which is submitted to be nonresponsive and thus insufficient.

As to a matter of design choice, as per the discussion of the claim above, first, the Examiner has not presented any evidence to support his contention that the change in shape is merely a matter of design choice. In the context of method claims where there has been no showing that the problem addressed by the instant claims has even been recognized in the prior art. (See the discussion in the Brief re the Southwestern decision.) Also, unlike the patent application at issue in *Kuhle* (see discussion above), the discussion in the instant specification of thematic packaging and conveying information by the different shapes in a method relating to thematic packaging distinguishes the instant patent application that in *Kuhle*. The Examiner is simply begging the question of obviousness.

As to the holding that "it has been held to be within the skill of a worker in the art to select a known material on the basis of its suitability for the intended use..." this again begs

the question of statutory obviousness. Applicant's Brief pointed out that the Examiner's reasoning is contradicted by Gossard's as the Examiner has not shown how the spring hinge in Gossard would be functional for its intended purpose if made of plastic, etc. as the Examiner contends. (See Brief section regarding this claim.) The Examiner has begged the question of obviousness and asserted his opinion rather than making out a case of *prima facie* obviousness based on reference evidence.

5. Claims 51, 53, 55, and 57

The Examiner again misconstrues the claims and does not address all the arguments presented in the Brief as regards the respective claims. The Board is respectfully requested to read the Brief in connection with the Examiner's Answer, which is submitted to be nonresponsive and thus insufficient.

The Examiner contends in the Answer at page 8 that the additional method steps are a mere duplication of parts. This is not correct as the method steps are not parts. Further, the result of the method steps involves components that cooperate in an integral manner. That is, one cannot argue, say, that gears in a mechanical transmission are a mere duplication of parts because the gears cooperate in an integral manner. The attention of the Board is drawn to Fig. 5, for example, which is thematic packaging in the form of a "sleeve of golf balls" but for housing respective articles instead of golf balls. As shown in Fig. 5, a representative product produced by the method steps is integral, not a mere duplication of parts.

Additionally, the Examiner has contended that the method steps are a mere matter of design choice, but as stated above regarding claims 8-15, something does not become an obvious matter of design choice merely because the Examiner says so. First, the Examiner has not presented any evidence to support his contention that the change in shape is merely a matter of design choice. In the context of method claims where there has been no showing that the problem addressed by the instant claims has even been recognized in the

prior art. (See the discussion in the Brief re the Southwestern decision.) Also, unlike the patent application at issue in *Kuhle* (see discussion above), the discussion in the instant specification of thematic packaging and conveying information by the different shapes in a method relating to thematic packaging distinguishes the instant patent application that in *Kuhle*.

The Examiner is simply begging the question of obviousness, and has not presented a *prima facie* case of statutory obviousness.

C. Claims 17, 49 (Gossard and Francis)

1. Claim 17

The Examiner has not responded to many arguments that were presented in the Brief. The attention of the Board is respectfully drawn to the Brief regarding this claim.

In the Answer at page 8, the Examiner contends that "CARD FOOTBALL" on the Francis design is a logo.

In reply, first, Appellant respectfully submits that every writing is not a logo, and the Examiner has not shown from the cited art whether "CARD FOOTBALL" is a logo as used in the claim requirements.

Second, the Examiner has not responded to the argument presented in the Brief at the bottom of page 61 regarding the cited Southwest decision. The problem addressed by the method of the instant claims has not been shown to have been recognized in the cited art, so a modification of the art to achieve the solution of the problem cannot be deemed obvious.

Third, the Examiner has not completely responded to the argument in the Brief that there has been no proper reason to combine at pages 8-9 of the Answer, with regard to one aspect of the argument in the Brief concerning a reason to combine Francis with Gossard, the Examiner contends that Francis is analogous art.

In reply, whether something is or is not analogous art is not in itself a reason to combine.

However, in response to this line of Examiner contention, the Appellant respectfully disputes that the Examiner has met his burden of proof that Francis is reasonably pertinent to the problem addressed by the inventor. See, e.g., *In re Clay*, 966 F.2d 656, 658-9, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). In accordance with *Clay*, in order to determine whether Francis is analogous art under the Examiner's theory, one must look to the purposes of the invention and the prior art in order to determine whether the reference is reasonably pertinent to the problem the invention attempts to solve. Accordingly, the Examiner's contention that they are reasonably pertinent because 'they are both shaped like sports balls' is not sufficient under *Clay*.

Francis is a design patent, and thus the problem it is trying to solve is that of an "ornamental design for an article of manufacture." 35 USC Sec. 171. However, this is definitely not the purpose of Appellant's invention.

Appellant's Background of the Invention (page 2) states: "In the past, packaging has mainly been used for one purpose – packaging!" and goes on to discuss the combination for combined marketing.

This distinguishes from the design patent of Francis, which can is an "ornamental design for an article of manufacture."

The Examiner contends in the Answer at page 9 that "Francis and Gossard are reasonably pertinent to the particular problem with which the applicant was concerned (i.e., packaging that is not merely packaging, but rather takes on some shape for which the article therein may be related thereto.)" However, this is an Examiner opinion, not a Francis design patent teaching. In other words, Francis does not state that it was concerned with "packaging... (that) takes on some shape for which the article therein may be related thereto,"

and the Examiner's opinion as to the particular problem being solved by Francis is mere Examiner speculation.

There is yet another basis for distinguishing Francis. Base claim 5 requires the package having a shape that is different than any shape to be contained therein. Applicant's filing of 21 October 2002 contained a trading card having the silhouette of a football shape comparable to the Francis shape, and the Examiner did not respond to this evidence. From the Francis design patent and evidence submitted by Appellant, the Examiner has not met his burden of proof that Francis has a shape that is different than any shape to be contained therein. Therefore, the Examiner has not presented a prima facie case of obviousness. (See also the reasons more to the point set out in the Brief.)

2. Claim 49

The Examiner has not addressed many arguments that were presented in the Brief. The attention of the Board is respectfully drawn to the Brief regarding this claim.

In the Answer at page 8, the Examiner contends that "CARD FOOTBALL" is a message on the package.

In reply, first, Appellant respectfully submits that this is not what the claim requires. Appellant relies on the argument in the Brief on this point, regarding the precise claim requirements include suggestive.... The Examiner contends at page 8 that the message "is suggestive because it tells the a user exactly what is in the package." In reply, this admission is fatal to the Examiner's obviousness case. Something that "tells the a user exactly what is in the package" per se is not suggestive. See 15 U.S.C. Sec. 1052 and TMEP Sec. 1209.

Second, the Examiner has not responded to the argument presented in the Brief at the bottom of page 61 regarding the cited Southwest decision. The problem addressed by the method of the instant claims has not been shown to have been recognized in the cited art, so a modification of the art to achieve the solution of the problem cannot be deemed obvious.

Third, the Examiner has not responded to the argument in the Brief that there has been no proper reason to combine. At pages 8-9 of the Answer, with regard to one aspect of the argument in the Brief concerning a reason to combine, the Examiner contends that Francis is analogous art.

In reply, whether something is or is not analogous art is not in itself a reason to combine.

However, in response to this aspect of the Examiner's "proper reason to combine" argument, the Appellant disputes that the Examiner has met his burden of proof that Francis is reasonably pertinent to the problem addressed by the inventor. See, e.g., *In re Clay*, 966 F.2d 656, 658-9, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). In accordance with *Clay*, in order to determine whether Francis is analogous art under the Examiner's theory, one must look to the purposes of the invention and the prior art in order to determine whether the reference is reasonably pertinent to the problem the invention attempts to solve. Accordingly, the Examiner's contention that they are reasonably pertinent because 'they are both shaped like sports balls" is inappropriate under *Clay*.

Francis is a design patent, and thus the problem it is trying to solve is that of an "ornamental design for an article of manufacture." 35 USC Sec. 171. However, this is definitely not the purpose of Appellant's invention.

Appellant's Background of the Invention (page 2) states:
"In the past, packaging has mainly been used for one purpose – packaging!"

This distinguishes from the design patent of Francis, which can is an "ornamental design for an article of manufacture."

The Examiner contends in the Reply at page 9 that "Francis and Gossard are reasonably pertinent to the particular problem with which the applicant was concerned (i.e.,

packaging that is not merely packaging, but rather takes on some shape for which the article therein may be related thereto.)” However, this is an Examiner opinion, not a Francis design patent teaching. In other words, Francis does not state that it was concerned with “packaging... (that) takes on some shape for which the article therein may be related thereto,” and the Examiner’s opinion as to the particular problem being solved by Francis is mere Examiner speculation.

There is yet another basis for distinguishing Francis. Base claim 5 requires the package having a shape that is different than any shape to be contained therein. Applicant’s filing of 21 October 2002 contained a trading card having the silhouette of a football shape comparable to the Francis shape, and the Examiner did not respond to this evidence. From the Francis design patent and evidence submitted by Appellant, the Examiner has not met his burden of proof that Francis has a shape that is different than any shape to be contained therein. Therefore, the Examiner has not presented a *prima facie* case of obviousness. (See also the reasons more to the point set out in the Brief.)

D. **Claim 23 (Gossard and Shaffer)**

In the Brief, many arguments were presented to which the Examiner has not responded addressed. The attention of the Board is respectfully drawn to the Brief concerning this claim.

Further, the Examiner has not responded to the argument presented in the Brief at the bottom of page 61 regarding the cited Southwest decision. The problem addressed by the method of the instant claims has not been shown to have been recognized in the cited art, so a modification of the art to achieve the solution of the problem cannot be deemed obvious.

Additionally, the Examiner has not completely responded to the argument in the Brief that there has been no proper reason to combine. At pages 8-9 of the Answer, with regard to one aspect of the argument in the Brief concerning a reason to combine, the

Examiner contends that Schaffer is analogous art.

In reply, whether something is or is not analogous art is not in itself a reason to combine.

However, if the Examiner wishes to pursue this line of reasoning, then Appellant disputes that the Examiner has met his burden of proof that Francis is reasonably pertinent to the problem addressed by the inventor. See, e.g., *In re Clay*, 966 F.2d 656, 658-9, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). In accordance with *Clay*, in order to determine whether Francis is analogous art under the Examiner's theory, one must look to the purposes of the invention and the prior art in order to determine whether the reference is reasonably pertinent to the problem the invention attempts to solve. Accordingly, the Examiner's contention that they are reasonably pertinent because 'they are both shaped like sports balls' is inappropriate under *Clay*.

As a legal standard, a reference is "analogous art" if it is within an inventor's field of endeavor or, if not within the same field of endeavor, if reasonably pertinent to the problem addressed by the inventor. See, e.g., *In re Clay*, 966 F.2d 656, 658-9, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992).

In the instant case, the Examiner does not contend that the inventor's field of endeavor is within the "RADIO" field of Schaffer (see title of Schaffer). As to whether Schaffer is at least reasonably pertinent to the problem appellant was attempting to solve, in accordance with *Clay*, one must look to the purposes of the invention and the prior art in order to determine whether the reference is reasonably pertinent to the problem the invention attempts to solve.

Schaffer is a design patent, and thus the problem it is trying to solve is that of an "ornamental design for an article of manufacture." 35 USC Sec. 171. However, this is definitely not the purpose of Appellant's invention.

Appellant's Background of the Invention (page 2) states:

"In the past, packaging has mainly been used for one purpose – packaging!"

This distinguishes from the design patent of Schaffer, which can is an "ornamental design for an article of manufacture."

Contrast Schaffer's ornamental design for an article of manufacture with the claimed combination of a thematic package and an article contained [therein] wherein the shape is visually suggestive of an activity... in which the article is used after removal from the package.

See Specification at page 3, line 30-page 4, line 2, and further from there; it is clear that the problem the Appellant was trying to solve pertained to thematic packaging of a combination wherein the article is for use subsequent to "removal" from the packaging. See specification at page 5, line 3. See claims re after removal from the package. This is not a purpose of taught by Schaffer design patent for a radio.

The Examiner contends in the Answer at page 9 that "Schaffer and Gossard are reasonably pertinent to the particular problem with which the applicant was concerned (i.e., packaging that is not merely packaging, but rather takes on some shape for which the article therein may be related thereto.)" However, this is an Examiner opinion, not a Schaffer design patent teaching. In other words, Schaffer does not state that it was concerned with "packaging... (that) takes on some shape for which the article therein may be related thereto," and the Examiner's opinion as to the particular problem being solved by Schaffer is mere Examiner speculation.

More so, if Schaffer were interpreted as the Examiner proposes, in order to make any innovation in the field of thematic packaging of a combination for combined marketing, ordinary artisan would be charged with knowledge of every shaped package regardless of the distinct purpose of a combination for combined marketing. An ordinary artisan has not been shown to have been knowledgeable of all shapes for all purposes.

There is yet another basis for distinguishing Schaffer. Base claim 5 requires the package having a shape that is different than any shape to be contained therein. From the Schaffer design patent, one would not know whether Schaffer has a shape that is different than any shape to be contained therein. It is the Examiner's burden to show a reason to combine, and the Examiner one cannot determine from the Schaffer design patent whether the proposed combination is permissible without knowing the shaped of the contents...which is not known from the evidence of record. This follows, of course, from the fact that Schaffer does not seem to contemplate removal of the circuitry for use – one does not know what is contained therein.

In sum, the Examiner has not shown why the skilled artisan involved in the purpose of the present invention would have considered Schaffer reasonably pertinent because the contents of Schaffer's RADIO design do not seem to have been intended for removal from the packaging. Nor has the Examiner shown why the skilled artisan involved in the purpose of the present invention would have considered Schaffer as reasonably pertinent Schaffer for a teaching wherein the article is for use subsequent to "removal" from the packaging.

Therefore, the Examiner has not presented a *prima facie case of obviousness*.
(See also the reasons more to the point set out in the Brief.)

D. Summary Regarding Sec. 103 Rejections

The legal standard for determining obviousness pursuant to 35 U.S.C. § 103 includes three factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The U.S. Supreme Court held that in applying Section 103, "the scope of the prior art is to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the art is to be ascertained." *Deere* at 17. Accordingly, the C.C.P.A. has ruled that 35 U.S.C. § 103 places the burden on the PTO to establish obviousness. *In re Reuter*, 651 F.2d 751, 210 U.S.P.Q. 249 (C.C.P.A. 1981).

In the present case, the Examiner has not properly construed the claims, e.g.,

construed the claims consistent with the prior Board decision in this application, and the Examiner has not correctly ascertained the differences between the prior art and the claims at issue.

In rejecting claims under 35 U.S.C. § 103, an examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.*

"A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 782, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 U.S.P.Q. 143, 147 (CCPA 1976)).

In the instant case, the Examiner has not presented a theory of Gossard that can be used consistently to reach all claim limitations of the independent claims (e.g., theories 1a, 1b, and 1c cannot be made to fit with other claim requirements). With no showing that the base claims are not patentable over the cited art, there is no adequate showing that the dependent claims are unpatentable.

When making a determination concerning obviousness, all limitations of the claim must be evaluated. 35 U.S.C. 103, *In re Miller*, 418 F.2d 1392, 64 USPQ 46 (CCPA 1969). See also *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). There must be some logical reason apparent from the record that would justify modification of the reference. *In re Royal* 188 USPQ 132 (CCPA 1975).

In the instant case, the Examiner has consistently mischaracterized the claims, e.g., not consistent with the prior Board decision in this application, and has not presented sufficient reasons apparent from the record that would justify modification of Gossard, e.g., by not completely answering the issues raised in the Brief.

Moreover, a combination of references to obviate a claim is improper unless the prior art suggests the combination or modification. More specifically, before the PTO can

combine the disclosure of two or more references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found in the references themselves or in the knowledge generally available to the person skilled in the art. In re Jones 21 USPQ2d 1941 (Fed. Cir. 1992).

In the instant case, the Examiner has not provided a proper reason to combine, as set out in the Brief, but not fully answered by the Examiner.

If the Examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

In the instant case, the Examiner has not met the statutory burden that is required for withholding a patent.

It is respectfully submitted that no one would ever have thought of a method for making a combination of a thematic package and a removable article contained in the package for combined marketing (as more precisely set out in the claims) from Gossard, except for the Examiner responding to Appellant's application for a patent. Further, the claims require method steps, not an article of manufacture, and the reason for the method has not even been found in the cited art, so the Examiner is speculating about a method from the inadequate evidence of the article in Gossard.

The claimed method steps, when correctly construed, are not anticipated by Gossard. The MPEP Sec. 2131 provides that:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. '*Verdicaal Bros. v. Union Oil Co. of California*, 814 F. 2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be found in as complete detail as contained in the ...claim." *Richardson v Suzuki Motor Co.*, 969 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required in the claim."

And as per In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990): "For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference...." Gossard does not teach the

claimed shape of the package visually suggestive of an activity associated with the icon in which the article is used during the activity, after removal from the package in combination with the claimed ...making a combination... for combined marketing. Accordingly, the Examiner has not presented sufficient evidence from the prior art of the totality of each claim 102-rejected claim was suggested to an ordinary artisan. Therefore, the rejections for statutory anticipation based on Gossard should be reversed.

II. CONCLUSION

The rejection of each group of Appellant's claims pursuant to Sec. 102 and Sec. 103 is in error because Appellant's claimed method steps, as a whole, are not disclosed or suggested in the cited reference(s). Applicant's continuation-in-part application claims priority since 1994, and the instant case has been pending for about 7 years, now through 2 appeals. At some point, examination must end the inevitable must be faced: the Examiner has not presented a sufficient case for withholding a patent. Wherefore, Applicant requests that the rejections be reversed.

Respectfully submitted,



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